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| 09/487,932      | 01/20/2000  | Richard Alan Fiedotin | 10160-02-999        | 3747             |

24341 7590 06/18/2004

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| EXAMINER |
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KALINOWSKI, ALEXANDER G

|          |              |
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| ART UNIT | PAPER NUMBER |
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3626

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

6

# Office Action Summary

Application No.

09/487,932

Applicant(s)

FIEDOTIN ET AL.

Examiner

Alexander Kalinowski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date 61104
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-44 are presented for examination. Applicant filed an amendment on 3/23/2004 amending claims 1, 12, 17, and 22 and adding new claims 27-44. In light of Applicant's amendment, the Examiner withdraws the outstanding rejection of claims 1-26 based on 35 USC 103. However, new grounds of rejection of claims 1-44 based on 35 USC 103 are established in the instant office action as set forth in detail below. Since the new grounds of rejection were necessitated by Applicant's amendment, the grounds of rejection of claims 1-44 are a final rejection of the claims.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edelson et al., Pat. No. 5,737,539 (hereinafter Edelson) in view of Bennahum, David, "Docs for Docs" (hereinafter Bennahum) and McCormick, Pub. No. 2002/0035484.

As to claim 1, Edelson discloses A method for distributing medical data to medical personnel (see abstract), said method comprising the steps of: storing medical data in a database (col. 8, lines 4-31); and

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periodically communicating selected medical data between said database and an electronic device to establish a medical data distribution system (col. 7, lines 10-31)

Edelson does not explicitly disclose  
a data distribution system that is at least partially subsidized by  
sponsoring entities.

However, Bennahum discloses a data distribution system subsidized by sponsoring entities (page 3, paragraphs 1 and 2). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include a data distribution system subsidized by sponsoring entities as disclosed by Bennahum within Edelson for the motivation of providing the data distribution system service free so that doctors will use the system ( page 3, paragraph 1).

Edelson and Bennahum do not explicitly disclose  
in response to a connection signal between a portable device and said database,  
automatically updating said portable electronic device with at least some of said  
medical data stored in said database.

However, McCormick discloses in response to a connection signal  
between a portable device and said database, automatically updating said  
portable electronic device with at least some of said medical data stored in said  
database (i.e. source initiated data from the PBM)(paragraphs 51-52 and  
paragraph 84). It would have been obvious to one of ordinary skill in the art at the  
time of Applicant's invention to include the aforementioned limitation as disclosed  
by McCormick within Edelson and Bennahum for the motivation of allowing drug

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companies to quickly reach physicians regarding information about drugs or with important messages (paragraphs 51-52 and paragraph 84).

As to claim 2, Edelson discloses A method according to claim 1, wherein said method further comprises the initial step of aggregating said medical data from multiple sources col. 7, lines 21-31).

As to claim 3, Edelson discloses A method according to claim 2, wherein said aggregating step further comprises collecting medical data selected from a group consisting of formulary and pharmacopoeia data (col. 8, lines 11-19 and col. 21 - col. 22).

As to claim 4, Edelson does not explicitly disclose A method according to claim 1, wherein said method further comprises the step of selling sponsorship rights to said sponsoring entity, wherein said sponsorship rights at least partly fund said medical data distribution system.

However, Bennahum discloses wherein said method further comprises the step of selling sponsorship rights to said sponsoring entity, wherein said sponsorship rights at least partly fund said medical data distribution system (page 3, paragraphs 1-2 and page 4, paragraphs 1-3). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein said method further comprises the step of selling sponsorship rights to said sponsoring entity, wherein said sponsorship rights at least partly fund said medical data distribution system as disclosed by Bennahum within Edelson for the motivation of providing the data distribution system service free so that doctors will use the system ( page 3, paragraph 1).

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As to claim 5, Edelson does not explicitly disclose A method according to claim 4, wherein said selling step comprises vending sponsorship rights to at least one sponsor selected from a group consisting of a pharmaceutical company; a pharmacy benefit management organization; a health care insurer; a pharmacy; a medical supplier; a medical publisher; a contract research organization or a managed care organization.

However, Bennahum discloses wherein said selling step comprises vending sponsorship rights to at least one sponsor selected from a group consisting of a pharmaceutical company; a pharmacy benefit management organization; a health care insurer; a pharmacy; a medical supplier; a medical publisher; a contract research organization or a managed care organization (page 3, paragraph 1 and page 4). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein said selling step comprises vending sponsorship rights to at least one sponsor selected from a group consisting of a pharmaceutical company; a pharmacy benefit management organization; a health care insurer; a pharmacy; a medical supplier; a medical publisher; a contract research organization or a managed care organization as disclosed by Bennahum within Edelson for the motivation of providing the data distribution system service free so that doctors will use the system ( page 3, paragraph 1).

As to claim 6, Edelson does not explicitly disclose A method according to claim 1, wherein said method further comprises the initial step of distributing said electronic device, at a subsidized or no cost, to medical personnel.

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However, Bennahum discloses wherein said method further comprises the initial step of distributing said electronic device, at a subsidized or no cost, to medical personnel (page 4, paragraphs 1-3). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein said method further comprises the initial step of distributing said electronic device, at a subsidized or no cost, to medical personnel as disclosed by Bennahum within Edelson for the motivation of providing the data distribution system service free so that doctors will use the system ( page 3, paragraph 1).

As to claim 7, Edelson does not explicitly disclose A method according to claim 6, wherein said distributing step comprises lending a handheld computing device to a physician, where said handheld computing device is subsidized by said sponsoring entities.

However, Bennahum discloses wherein said distributing step comprises lending a handheld computing device to a physician, where said handheld computing device is subsidized by said sponsoring (page 4, paragraphs 1-3). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein said distributing step comprises lending a handheld computing device to a physician, where said handheld computing device is subsidized by said sponsoring entities as disclosed by Bennahum within Edelson for the motivation of providing the data distribution system service free so that doctors will use the system ( page 3, paragraph 1).

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As to claim 8, Edelson, Bennahum, and McCormick do not explicitly disclose A method according to claim 1, wherein said method further comprises the step of placing indicia of the sponsored entity on said electronic device.

However, the Examiner takes official notice that it was well known in the electronic device arts to place indicia of a sponsoring entity on an electronic device. For example, cellular phone companies provide cellular phone services to customers. Oftentimes, these cellular phone companies provide rebates or reduced prices on cellular phones manufactured by other companies in conjunction with introductory cellular phone services. The telephone, in addition to containing the indicia of the manufacturer also contains an indicia of the cellular phone company providing the rebate or discount. The purpose of the indicia is to draw the customer's attention to the cellular phone service provider's identity, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein said method further comprises the step of placing indicia of the sponsored entity on said electronic device within the Edelson, Bennahum, and McCormick combination for the motivation stated above.

As to claim 9. Edelson discloses A method according to claim 1, wherein said communicating step further comprises the steps of receiving a request for medical data from said electronic device (col. 12, lines 22-42 and col. 37, lines 53-67); and responding to the request by sending at least a portion of said medical data to said electronic device (col. 12, lines 22-42 and col. 37, lines 53-67).



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As to claim 10, Edelson discloses A method according to claim 1, wherein said communicating step further comprises the steps of sending a query to said electronic device (Fig 3-10); and receiving a response to the query from said electronic device, where the response is determined by a choice made by medical personnel when presented with the query (Fig 3-10).

As to claim 11, Edelson discloses A method according to claim 1, wherein said communicating step further comprises the step of downloading executable instructions to the electronic device, wherein said executable instructions are capable of running on the electronic device (col. 7, lines 10-27).

As to claims 12-26, the claims are substantially similar to claims 1-11 and are rejected on the same basis.

As to claim 27, Edelson and Bennahum do not explicitly disclose the method of claim 27 further comprising displaying an advertisement of a sponsoring entity during said updating.

However, McCormick discloses displaying an advertisement of a sponsoring entity during said updating (paragraph 52). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by McCormick within Edelson and Bennahum for the motivation of allowing drug companies to quickly reach physicians regarding information about drugs or with important messages (paragraphs 51-52 and paragraph 84).

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As to claims 28-29, Edelson, Bennahum and McCormick do not explicitly disclose the method of claim 27 hyper linking from an advertisement to a website of a sponsoring entity or automatically launching a website of said sponsoring entity.

However, the Examiner takes official notice that it was well known in the electronic advertisement arts to hyperlink to web sites of entities (i.e. banner advertisements). The motivation would have been to draw attention to a company's line of product and/or services (i.e. marketing products/services). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation within Edelson and Bennahum for the motivation stated above.

As to claim 30, Edelson and Bennahum do not explicitly disclose the method of claim 27 further comprising prior to said displaying downloading said advertisement or a hyperlink to a website of a sponsoring entity.

However, McCormick discloses prior to said displaying downloading said advertisement (paragraphs 51-52 and paragraph 84). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by McCormick within Edelson and Bennahum for the motivation of allowing drug companies to quickly reach physicians regarding information about drugs or with important messages (paragraphs 51-52 and paragraph 84).

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As to claim 31, Edelson and Bennahum do not explicitly disclose the method of claim 1 wherein said updating includes sending customized messages to physicians.

However, McCormick discloses said updating includes sending customized messages to physicians (i.e. emails ... and other desired information)(paragraph 7). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by McCormick within Edelson and Bennahum for the motivation of allowing drug companies to quickly reach physicians regarding information about drugs or with important messages (paragraphs 51-52 and paragraph 84).

As to claims 32-33, Edelson, Bennahum and McCormick do not explicitly disclose the method of claim 31 prior to said updating, customizing said messages based at least partially on a physician's profile.

However, the Examiner takes official notice that it was well known in the electronic advertising arts to target advertisements to classes of users based on a profile. The motivation would have been to deliver advertisements to those users that are more likely to be interested in the subject matter of the advertisement thereby increasing the effectiveness of the advertisement. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation within Edelson, Bennahum, and McCormick for the motivation stated above.

As to claim 34, Edelson, Bennahum and McCormick do not explicitly disclose the method of claim 1 comprising, prior to said storing, distributing said

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portable electronic device to physicians, where ownership of said portable electronic device remains with the sponsoring entities.

However, the Examiner takes official notice that it was well known in industry for employers (i.e. subsidizing entities) to provide electronic devices (i.e. computer, laptops, palm devices) free of charge to employees. The motivation would have been to provide an incentive to an employee to use tools provided by a subsidizing entity (i.e. employer) while retaining a property right to the tool in the event the employment relationship is terminated. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation within Edelson, Bennahum, and McCormick for the motivation stated above.

As to claim 35, Edelson, Bennahum and McCormick do not explicitly disclose the method of claim 1 further comprising displaying a reminder screen to a physician to synchronize said portable electronic device.

However, the Examiner takes official notice that it was well known in the electronic scheduling arts to provide reminders to users for scheduled events (i.e. upcoming meetings, to-do lists). The purpose would be to make sure the user does not forget about a scheduled event that will occur. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation within Edelson and Bennahum for the motivation stated above.

As to claims 36-38, Edelson, Bennahum and McCormick do not explicitly disclose

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downloading to said portable electronic device an industry specific trivia games.

However, the Examiner takes official notice that it was well known in the electronic advertising and marketing arts to use games as a marketing/advertising tool. The motivation would have been to encourage use of the system by the user. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation within Edelson and Bennahum for the motivation stated above.

As to claims 39-44, the claims are similar in scope to claims 1-31 and are rejected on the same basis.

#### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-44 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure..

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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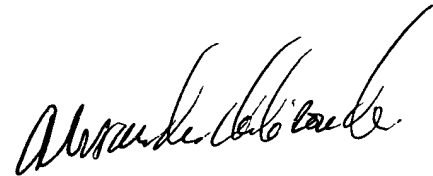
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

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If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.

A handwritten signature in black ink, appearing to read 'Alexander Kalinowski', with a stylized, cursive script.

Alexander Kalinowski

Primary Examiner

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6/12/04